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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/938,294      | 08/24/2001  | Gregory J. Hinkle    | 16517.253           | 1056             |

7590 03/25/2003

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[REDACTED] EXAMINER

BUI, PHUONG T

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1638

DATE MAILED: 03/25/2003

*b*

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |   |                                      |  |  |  |   |   |  |
|---|---|--------------------------------------|--|--|--|---|---|--|
| <b>Office Action Summary</b>  | Application No.<br><b>09/938,294</b>  | Applicant(s)<br><b>Hinkle et al.</b> |  |  |  |   |   |  |
|   | Examiner<br><b>Phuong Bui</b>   | Art Unit<br><b>1638</b>              |  |  |  |   |   |  |
|    |   |                                      |  |  |  |   |   |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>  |   |                                      |  |  |  |   |   |  |
| <b>Period for Reply</b><br>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.   |   |                                      |  |  |  |   |   |  |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |   |                                      |  |  |  |   |   |  |
| <b>Status</b> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Aug 24, 2001</u></p> <p>2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>  |   |                                      |  |  |  |   |   |  |
| <b>Disposition of Claims</b> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-13</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input type="checkbox"/> Claim(s) _____ is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input checked="" type="checkbox"/> Claims <u>1-13</u> are subject to restriction and/or election requirement.</p>   |   |                                      |  |  |  |   |   |  |
| <b>Application Papers</b> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.<br/>Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.<br/>If approved, corrected drawings are required in reply to this Office action.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>  |   |                                      |  |  |  |   |   |  |
| <b>Priority under 35 U.S.C. §§ 119 and 120</b> <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> <li>1. <input type="checkbox"/> Certified copies of the priority documents have been received.</li> <li>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</li> <li>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> </ol> <p>*See the attached detailed Office action for a list of the certified copies not received.</p>  |   |                                      |  |  |  |   |   |  |
| <p>14) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p> <p>a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>   |   |                                      |  |  |  |   |   |  |
| <b>Attachment(s)</b> <table style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%;">1) <input type="checkbox"/> Notice of References Cited (PTO-892)</td> <td style="width: 50%;">4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</td> </tr> <tr> <td>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</td> <td>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</td> </tr> <tr> <td>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</td> <td>6) <input type="checkbox"/> Other: _____</td> </tr> </table>  |   |                                      | 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ | 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: _____ |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |                                      |  |  |  |   |   |  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |                                      |  |  |  |   |   |  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____   | 6) <input type="checkbox"/> Other: _____                                    |                                      |  |  |  |   |   |  |

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5 and 8-10, drawn to an isolated polynucleotide and transformed host cells and plants, classified in class 536, subclass 23.6.
  - II. Claim 6, drawn to a substantially purified protein, classified in class 530, subclass 372.
  - III. Claim 7, drawn to a purified antibody, classified in class 424, subclass 132.1.
  - IV. Claims 11-13, drawn to a transformed plant with transcribed strand complementary to a nucleic acid molecule, classified in Class 800, subclass 312.

For each of inventions I-IV above, restriction to one of the following is also required under 35 USC 121. Therefore, election is required of one of inventions I-IV and one of inventions (A)-(AQ).

- (A). SEQ ID No: 1 or a sequence encoding SEQ ID No: 44.
- (B). SEQ ID No: 2 or a sequence encoding SEQ ID No: 45.
- (C). SEQ ID No: 3 or a sequence encoding SEQ ID No: 46.
- (D). SEQ ID No: 4 or a sequence encoding SEQ ID No: 47.
- (E). SEQ ID No: 5 or a sequence encoding SEQ ID No: 48.
- (F). SEQ ID No: 6 or a sequence encoding SEQ ID No: 49.

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- (G). SEQ ID No: 7 or a sequence encoding SEQ ID No: 50.
- (H). SEQ ID No: 8 or a sequence encoding SEQ ID No: 51.
- (I). SEQ ID No: 9 or a sequence encoding SEQ ID No: 52.
- (J). SEQ ID No: 10 or a sequence encoding SEQ ID No: 53.
- (K). SEQ ID No: 11 or a sequence encoding SEQ ID No: 54.
- (L). SEQ ID No: 12 or a sequence encoding SEQ ID No: 55.
- (M). SEQ ID No: 13 or a sequence encoding SEQ ID No: 56.
- (N). SEQ ID No: 14 or a sequence encoding SEQ ID No: 57.
- (O). SEQ ID No: 15 or a sequence encoding SEQ ID No: 58.
- (P). SEQ ID No: 16 or a sequence encoding SEQ ID No: 59.
- (Q). SEQ ID No: 17 or a sequence encoding SEQ ID No: 60.
- (R). SEQ ID No: 18 or a sequence encoding SEQ ID No: 61.
- (S). SEQ ID No: 19 or a sequence encoding SEQ ID No: 62.
- (T). SEQ ID No: 20 or a sequence encoding SEQ ID No: 63.
- (U). SEQ ID No: 21 or a sequence encoding SEQ ID No: 64.
- (V). SEQ ID No: 22 or a sequence encoding SEQ ID No: 65.
- (W). SEQ ID No: 23 or a sequence encoding SEQ ID No: 66.
- (X). SEQ ID No: 24 or a sequence encoding SEQ ID No: 67.
- (Y). SEQ ID No: 25 or a sequence encoding SEQ ID No: 68.
- (Z). SEQ ID No: 26 or a sequence encoding SEQ ID No: 69.

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- (AA). SEQ ID No: 27 or a sequence encoding SEQ ID No: 70.
- (AB). SEQ ID No: 28 or a sequence encoding SEQ ID No: 71.
- (AC). SEQ ID No: 29 or a sequence encoding SEQ ID No: 72.
- (AD). SEQ ID No: 30 or a sequence encoding SEQ ID No: 73.
- (AE). SEQ ID No: 31 or a sequence encoding SEQ ID No: 74.
- (AF). SEQ ID No: 32 or a sequence encoding SEQ ID No: 75.
- (AG). SEQ ID No: 33 or a sequence encoding SEQ ID No: 76.
- (AH). SEQ ID No: 34 or a sequence encoding SEQ ID No: 77.
- (AI). SEQ ID No: 35 or a sequence encoding SEQ ID No: 78.
- (AJ). SEQ ID No: 36 or a sequence encoding SEQ ID No: 79.
- (AK). SEQ ID No: 37 or a sequence encoding SEQ ID No: 80.
- (AL). SEQ ID No: 38 or a sequence encoding SEQ ID No: 81.
- (AM). SEQ ID No: 39 or a sequence encoding SEQ ID No: 82.
- (AN). SEQ ID No: 40 or a sequence encoding SEQ ID No: 83.
- (AO). SEQ ID No: 41 or a sequence encoding SEQ ID No: 84.
- (AP). SEQ ID No: 42 or a sequence encoding SEQ ID No: 85.
- (AQ). SEQ ID No: 43 or a sequence encoding SEQ ID No: 86.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions (A)-(AQ) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects.

3. Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to divergent molecules having different functions and effects. The polynucleotides can be used in hybridization assays as well as in expression methods for producing the polypeptides. The antibodies may be used for purifying the protein from extracts as well as for detection methods for detecting a successful transformation. The plant transformed with the complement will not express the protein and may exhibit divergent morphological characteristics.

4. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

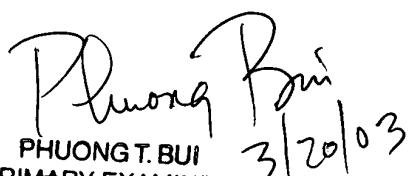
7. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996. The Examiner can normally be reached Monday-Friday from 6:30 AM - 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui  
Primary Examiner  
Group Art Unit 1638  
March 20, 2003

  
PHUONG T. BUI  
PRIMARY EXAMINER  
3/20/03